

Amendments to the Drawings:

Please add the new drawing Fig. 18 submitted herewith.

Enclosure: One (1) New Sheet of drawings illustrating new Fig. 18.

REMARKS

Summary of the Office Action

In the Office Action dated June 1, 2007, Claims 1-6 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement, Claims 7-15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable in light of various prior art documents of record in the application, and Claim 15 was rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Further, the drawings were objected to under 37 C.F.R. § 1.83(a) because they allegedly fail to show subject matter described in the specification. Finally, there is an incomplete (most likely unintended) indication in Item 11 of the Detailed Action that the application may be subject to a restriction requirement.

Summary of the Amendment

Upon entry of this Amendment, Claims 7-15 will have been canceled without prejudice or disclaimer. Accordingly, Claims 1-6 will be currently pending. All rejections and objections are respectfully traversed. Applicant nonetheless requests that the attached new drawing Fig. 18 be added to the application together with corresponding changes to the Specification, neither addition adding any new matter to the application. Finally, the incomplete indication that the application may be subject to a restriction requirement, if it was intended, is respectfully traversed together with the election of all now pending Claims 1-6 for further prosecution.

Priority

The Office Action states that “should applicant desire to obtain the benefit if foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of interference, a translation of the foreign application should be submitted under 37 C.F.R. 1.55 in reply to this action.” Since no interference is pending or appears to be imminent, applicant is not submitting a translation at this time.

Rejections under 35 U.S.C. § 112/1 of Claims 1-6

Applicant respectfully traverses the rejection of Claims 1-6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Applicant is uncertain whether the Examiner's rationale for the rejection is that the claims have not been enabled or rather that no specific definition is disclosed for a term used in the claims. Applicant has therefore provided responsive arguments with respect to both rationales.

Traversal with respect to there not being enabling disclosure in the application as originally filed for each of Claims 1-6.

Applicant respectfully traverses the finding that the application does not enable one skilled in the art to make and use the invention defined by Claim 1. To meet the enablement requirement, Applicant is only required to enable one embodiment of the present invention upon which Claim 1 reads, and Applicant has enabled at least several such embodiments.

Particularly with regard to the term "predefined criteria", originally filed Claims 2 and 3 teach that it may be set according to whether all the test pattern images look alike to an operator or according to whether selected contrast areas of test pattern images are visible. Applicant respectfully points out that originally filed claims are part of the original disclosure, and therefore provide supporting disclosure of the claimed subject matter.

The Summary of the Description and Description of the Preferred Embodiments further enable the "predefined criteria". Paragraph [0011] describes taking into consideration vision characteristics of a viewer. Paragraphs [0049] through [0061] describe the implementation and operation of a software program that adjusts a LUT 2 so that all test patterns appear at the same contrast to an operator. For this program, paragraph [0050] discloses that the background value of the image seen by the operator is preferably free from variations, the image data of a test pattern is varied with the LUT 2 fixed, and the operator views

the image and then adjusts the LUT 2. Paragraph [0051] discloses details relevant to using a cursor 7 and buttons 5 and 6 with the disclosed program to vary the contrast of a test pattern in response to the selected button. Paragraph [0052] discloses detail relevant to how to make test patterns appear at the same contrast. In particular, in this embodiment, an operator selects button 5 if the test pattern is difficult to view with a low contrast, or button 6 if the test pattern is too high in contrast in comparison to other test patterns. Further technical detail for enabling the “predefined criteria” in this embodiment is disclosed in the next forty paragraphs of the Specification, which includes paragraph [0053] through [0082]. Paragraphs [0076] and [0077], for example, state that a “series of these steps is repeated until the operator determines that all test patterns appear the same. When the algorithm ends after the operator determines that the test patterns are substantially identical to each other (step S105), gradients a1 through a4 are determined. The LUT 2 is modified based on the resulting gradients a1 through a4.” Moreover, paragraphs [0083] and [0084] disclose another embodiment of the present invention upon which Claim 1 reads wherein a specification is set up that contrast areas 12 falling within a range from the top row to a predetermined row and from the leftmost column to a predetermined column must be visible. Additional support for how to enable the “predefined criteria” and the other limitations of Claim 1 are found in additional embodiments of the present invention described throughout the remainder of the Description of the Preferred Embodiments from paragraph [0085] through [0120]. These points are also variously applicable to Claims 2 and 3, and since the rejection of Claims 4-6 is premised entirely on their dependency on Claim 1, apply to Claims 4-6 as well.

Applicant further submits that there is so much enabling disclosure for the term “predefined criteria” found throughout the Summary of the Invention, Description of the Preferred Embodiments, Figures, and originally filed claims (used as disclosure), that if Applicant were to discuss all of it in these Remarks, Applicant would essentially be repeating the bulk of the application as originally filed merely to respond to an Office Action.

Traversal with respect to there being any requirement in U.S. patent law that terms used in a claim be specifically defined in the Specification.

Applicant respectfully traverses the finding that there is a legal requirement in U.S. patent law that terms used in claims be specifically defined in the Specification.

An applicant may choose to be his own lexicographer by specifically defining terms. However, there is no requirement that an applicant actually be his own lexicographer. Most applicants choose not to do so because they can be bound by any definition provided. Thus, the vast majority of allowed claim terms used by patentees are not specifically defined in their respective disclosures, and Applicant should not be held to a different or higher standard than such patentees.

Applicant believes that the Examiner disfavors the term “predefined criteria” merely because it is not recited in the Description of the Preferred Embodiments. While there may be some foreign jurisdictions that specifically require that all claim terms be recited in a Description of Preferred Embodiments (or an application section similar thereto), this simply is not the law in the United States. For instance, applicants are allowed to use terms that are broader in scope than those used to describe any one or more particular embodiments in the Description of the Preferred Embodiments.

Applicant again notes that the original disclosure includes the originally filed claims. Thus, because the subject term “predefined criteria” is recited in the originally filed claims, (explicitly in originally filed Claims 1-3 and through dependency in originally filed Claims 4-6), it is by definition recited in the original disclosure, and any rejection based on the term lacking antecedent support cannot possibly be correct.

In summary, Applicant has claimed the present invention using a well known term “predefined criteria”. Applicant has further delineated “the predefined criteria”, for example, in Claims 2 and 3. Applicant has also disclosed and enabled in the Summary of the Invention, Description of the Preferred Embodiments, Figures, and originally filed claims (used as disclosure) numerous

embodiments of these claims, including enablement of the term “predefined criteria” as addressed above under the previous sub-heading “Traversal with respect to there not being enabling disclosure in the application as originally filed for each of Claims 1-6”. Applicant respectfully submits that this more than meets the requirements of 35 U.S.C. § 112, first paragraph. Applicant is not required to draft claims that only use terms that also appear in the Description of the Preferred Embodiments nor to be his own lexicographer by providing a specific definition for the term “predefined criteria” or any other term.

Therefore, Applicant respectfully submits that each of Claims 1-6 meets the requirements of 35 U.S.C. § 112, first paragraph, and respectfully requests that the Examiner indicate the allowance of these claims.

Rejections under 35 U.S.C. § 103(a) of Claims 7-15 and Rejection under 35 U.S.C. § 101 of Claim 15

Applicant has canceled Claims 7-15 without prejudice or disclaimer merely to expedite prosecution of the application. Therefore, the aforementioned rejections have been rendered moot. Applicant respectfully reserves to right to file a continuing application to further prosecute Claims 7-15, should such be desired.

Drawing Objection, and Amendments of Specification and Drawings to add new Fig. 18

The drawings have been objected to under 37 C.F.R. § 1.83(a) because they allegedly fail to show subject matter described in the specification. Applicant respectfully traverses. Applicant notes that said subject matter identified by the Examiner in Item 3 of the Detailed Action may be implemented, for example, using the image display apparatus illustrated in Fig. 1 and described thoroughly in the Specification.

The drawing objection is further addressed by the addition of a new drawing Fig. 18 to the application, the amendment of paragraphs [0012] and [0013] of the Specification to include the reference marks shown in the new

drawing Fig. 18, the addition of a new paragraph [0033.1] to the Specification to provide a brief description of the new drawing Fig. 18, and the remarks included below that identify supporting disclosure in the application as originally filed for the various changes to the Specification and for all the components and interconnectivity illustrated in the new drawing Fig. 18. No new matter has been added to the application.

With respect to the Specification, Applicant has amended paragraphs [0012] and [0013] as follows. First, the text “as shown in Fig. 18” has been added after “an apparatus for processing an image” merely to identify where the new drawing is located in the figures. Second, various reference marks have been added to the components disclosed in the aforementioned paragraphs. Third, a new paragraph [0033.1] has been added to provide a brief description of Fig. 18 entirely consistent with original paragraphs [0012] and [0013]. Since these changes merely provide drawing references and brief descriptions for disclosure already present in the application as originally filed, Applicant respectfully submits that no new matter has been added.

With respect to the Drawings, new drawing Fig. 18 includes various components identified and supported, for example, by paragraphs [0012], [0013], and [0036] of the application as originally filed. In particular, there are: an image generating unit 51 supported, for example, by lines 5-7 of page 4; a tonal gradation conversion unit 52 supported, for example, by lines 7-9 of page 4; a lookup table 53 supported, for example, by line 9 of page 4; a display unit 54 supported, for example, by lines 9-12 of page 4; an input unit supported, for example, by lines 12-15 of page 4; a control unit 56 supported, for example, by lines 16-24 of page 4; a selecting unit 57 supported, for example, by line 24 of page 4 through line 1 of page 5; and a calculating unit 58 supported, for example, by lines 1-4 of page 5. Support for lookup table 53 is found, for example, in lines 7-9 of page 4 and lines 4-8 of page 8. All line and page numbers here are relative to the application as originally filed for the Examiner’s convenience in verifying that no new matter has been added. Since all components are disclosed in the

application as originally filed, Applicant respectfully submits that no new matter has been added.

The illustrated interconnection of the components shown in Fig. 18 is also disclosed by the application as originally filed. In particular, the functional interconnection of the lookup table 53 with the tonal gradation conversion unit 52 is supported, for example, by lines 7-9 of page 4 and lines 4-8 of page 8; the interconnection of the image generating unit 51 with the tonal gradation conversion unit 52 is supported, for example, by lines 7-9 of page 4; the interconnection of the tonal gradation conversion unit 52 with the display unit 54 is supported, for example, by lines 9-12 of page 4; the interconnection of the control unit 56 with the tonal gradation conversion unit 52 is supported, for example, by lines 16, 20, 23-24 of page 4; the interconnection of the control unit 56 with the input unit 55 is supported, for example, by lines 12-16, 18-19, and 22-23 of page 4; the interconnection of the control unit 56 with the image generating unit 51 is supported, for example, by lines 16-18 of page 4; the interconnection of the control unit 56 with the calculating unit 58 is supported, for example, by lines 1-4 of page 5 including “calculating the lookup table” and lines 21-24 of page 4 including “control ... for displaying the pattern image with the lookup table modified”; the interconnection of the control unit 56 with the selecting unit 57 is supported, for example, by lines 24 of page 4 through line 1 of page 5 including “selecting the pattern image presented on the display unit”, and by lines 21-24 of page 4 including “control...for displaying the pattern image”; and finally the interconnection of the calculating unit 58 with the lookup table 53 is supported, for example, by lines 1-4 of page 5. All line and page numbers here are relative to the application as originally filed. Since all these interconnections are disclosed in the application as originally filed, Applicant respectfully submits that no new matter has been added.

Incomplete Indication of Restriction Believed to be Unintentional, Traversal of Restriction, and Election of All Now Pending Claims 1-6 for Prosecution

Applicant respectfully notes that there is an incomplete indication in Item 11 of the Detailed Action that the application may be subject to a restriction requirement.

In particular, the Office Action indicates under the heading “Correspondence Information” that:

11. Claims 1-6 may be allowable if these claims are NOT rejected under 35 U.S.C. § 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

However, Applicant has reviewed of the Office Action and sees no further indication anywhere else that any claims are subject to restriction.

Applicant respectfully submits that the Correspondence Information Section would be a very odd place to first mention an intended requirement of restriction and/or election of species, and given that the quoted passage occurs in what may be boilerplate common provisions added at the end of Office Actions generally, further submits that the inclusion of the above-quoted passage in the Office Action was, in all likelihood, merely an inadvertent error either unintended on the part of the Examiner or alternatively intended merely to remind Applicant that a cancellation of claims, for whatever reason, might result in a change of inventorship.

Applicant respectfully requests that the Examiner clarify this issue. Applicant notes however that the Office Action does specify that “Applicant is

advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143)” Accordingly, for the sake of being complete as required, (and conditioned precedent on the restriction requirement being intended), Applicant respectfully elects all of the now pending Claims 1-6 for further prosecution. The non-election of the canceled Claims 7-15 has been made only because those claims have been canceled, and Applicant intends no loss of the right to file a continuing application to further prosecute Claims 7-15 if so desired.

Applicant notes that it is necessary to know whether a restriction was actually intended so that Applicant will know whether to file a divisional application or a continuation application, should further prosecution of Claims 7-15 be desired.

CONCLUSION

Applicant respectfully submits that all of the claims pending in the application meet the requirements for patentability and respectfully requests that the Examiner indicate the allowance of such claims.

Any amendments to the claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If any additional fee is required, please charge Deposit Account Number 502456. Should the Examiner have any questions, the Examiner may contact Applicant's representative at the telephone number below.

Respectfully submitted,

Date: September 4, 2007 By:

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